

REMARKS

Claims 13, 17-21, and 24-36 are in the case and presented for consideration.

Claims 31-36 have been rejected due to an antecedent basis issue in claim 31. The issue has been corrected and the amendment was not made to overcome prior art. Accordingly, applicant reserves all rights under the Doctrine of Equivalents and is entitled to the full scope of equivalents.

Claims 13, 17, 19-21, 24-25, 27-29, 31-32, and 34-36 have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Applicant respectfully submits that the Office has not established a *prima facie* case of unpatentability. In order to establish a *prima facie* case, the Office must show that the claim as a whole, considering all limitations, is unpatentable. MPEP 2106(II)(c) states that “USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation...The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined.” The present Office Action states that “although claims 13 and 31 recite a transmitter, the claimed transmitters merely include a processor for arranging a data signal including data items.” However, claims 13 and 31 recite more than just a processor arranging a data signal including data items. Since the Office has not explained how the remaining elements and limitations of the claim(s) factor into the determination, the Office has not established a *prima facie* case of unpatentability.

In addition, the Office has not even attempted to establish a *prima facie* case of unpatentability for any of the dependent claims. MPEP 2106(IV)(D) states that “After USPTO personnel identify and explain in the record the reasons why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either

amend the claim or make a showing of why the claim is eligible for patent protection.”

Since the Office has failed to identify and explain in the record the reasons why all of the dependent claims are for an abstract idea with no practical application, the burden has not shifted to the applicant to amend the claim or make a showing of why the claim is eligible for patent protection. Also, since the burden has not shifted to the applicant, the Office is not permitted to make a next action final upon any *prima facie* showing since applicant must be given a chance to rebut any *prima facie* showing that is proffered in any later Office action.

Notwithstanding the above, applicant respectfully submits that claim 13 is statutory subject matter. MPEP2106(IV)(B) states that “To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter). The claimed transmitter clearly falls under either of the enumerated categories of “machine” or “manufacture”.

MPEP 2106(IV)(C) then states that “Determining whether the claim falls within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter) does not end the analysis because claims directed to **nothing more than** abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” (emphasis added).

Applicant respectfully submits that claim 13 recites among other things a transmitter for transmitting a data signal including a plurality of data items. Claim 13 further recites that the transmitter comprises a processor. The processor is further limited by a specific

function, namely arranging the data signal to include certain elements. The processor functions to arrange the data signal to include a field indicating the number of data items, wherein each data item includes an identifier. As part of this arrangement by the processor, the plurality of identifiers form an ordered sequence. Also as part of this arrangement by the processor, the field comprises a first and second subfield where the subfields represent a range of the sequence of identifiers. It **cannot** be said that claim 13 is directed to **nothing more than** one of the 35 U.S.C. 101 judicial exceptions.

Claim 13 characterizes the transmitter **structurally** as having a processor which is characterized as capable of carrying out a function with a concrete (i.e., both the transmitter/processor structure and the functionality of the processor are reproducible so that the result is reproducible) and tangible result (i.e., the arrangement of the data signal to include a plurality of data items that each include an identifier, a field comprising first and second subfields and indicating the number of data items, and an ordered sequence of identifiers). Contrary to the Office's position, the processor arranges much more than a data signal including data items, which is the reason that the Office has not even established a *prima facie* case of unpatentability. Also, a transmitter may have many components. 35 U.S.C. 101 does not require applicant to claim each and every component. In fact, there is no such requirement anywhere in the patent law. Rather, 35 U.S.C. 101 only requires that applicant claim an invention that falls within one of the enumerated statutory categories and is "new and useful". Applicant has satisfied these requirements by claiming a transmitter with a processor which falls into the enumerated categories of machine and manufacture and is useful as being capable of arranging data items, fields, and identifiers **in a specific manner**. The usefulness of the arrangement is not just limited to the specific manner of the arrangement, but also as explained on page 2,

lines 22-33 continuing to page 3, lines 1-10. This is not analogous to a mere collection of data such as a collection of musical works for example.

The Office states that “The arrangement is purely descriptive non functional and does not characterize the transmitter in any way”. Applicant respectfully disagrees. Claim 13 does **not** claim **an arrangement alone**. Rather, claim 13 claims a transmitter comprising a processor for carrying out arrangement of a number of elements, wherein both the processor’s functionality in carrying out the arrangement and the result of the arrangement (page 2, lines 22-33 continuing to page 3, lines 1-10) are useful. Therefore, the argument that “the arrangement is purely descriptive non functional” is without merit. Also, applicant reiterates that since claim 13 recites a transmitter comprising a processor, the transmitter is characterized by the processor. The processor is an element of the transmitter. The argument that “The arrangement....does not characterize the transmitter in any way” is without merit because claim 13 does not attempt to characterize the transmitter by the arrangement. It is the claimed processor (and not the arrangement) which characterizes the transmitter.

Applicant respectfully submits that claim 31 is patentable for at least the same reasons as described above. Furthermore, claim 31 now additionally recites “means for transmitting said field and data items”. Accordingly, not only is the transmitter characterized by the claimed processor, but the transmitter is now also characterized by the claimed means for transmitting. The usefulness of the transmitter not only lies in the processor and its capability to arrange the data items, fields, subfields, and identifiers, but also the transmission of the arrangement of data items, fields, subfields, and identifiers. Claim 31 is believed to be patentable. Claims 37 and 38 further characterize the transmitter and are equally patentable.

The Office further rejects claim 24 on generally the same grounds as claims 13 and 31. That is, claims 24 and 30 are generally rejected because “the data items are merely descriptive non-functional”. Again, applicant reiterates that claims 24 and 30 do not solely claim the data items. Rather, claims 24 and 30 claim a set of steps which include **among other things**, generating a plurality of data items and adding an identifier to each data item. The method in claim 24 achieves a concrete and tangible result (i.e., the result of adding an identifier to each data item, the plurality of data items forming an ordered sequence; generating a field....comprising a first and second subfield, the subfields representing the range of said sequence of identifiers). The resulting generated data signal has a usefulness that is set forth in page 2, lines 22-33 continuing to page 3, lines 1-10.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

The Commissioner is hereby authorized to credit any overpayment or charge any fee (except the issue fee) to Account No. 14-1270.

Respectfully submitted,

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